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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,062	08/10/2001	K. M. Slimak	TPP-30420	5284

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09/09/2003

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EXAMINER

BARR, MICHAEL E

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 09/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/927,062	Applicant(s) SLIMAK ET AL.	
	Examiner Michael Barr	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22, 23 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22 and 23 is/are allowed.
- 6) ☒ Claim(s) 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Applicant Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>0803</u> | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Response to amendments

1. Applicant's arguments and amendments, filed 8/8/2003, have been fully considered and reviewed by the examiner. In light of the amendments, the rejections made in the previous office action have been withdrawn by the examiner. The examiner acknowledges the addition of Claims 25-27 and the cancellation of Claims 1-21 and 24. Claims 22-23 and 25-27 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most ~~neely~~ connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 26 cites the limitation that the wood fibers are separated from one another by the harden silicate. This is not described in the specification, as originally filed, and thus is considered new matter.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27 cites the limitation of applying the solution by "industrial wood-preserving operations". It is not clear as to what is meant by this limitation as it is not clearly defined in the specification. Does this merely refer to any wood impregnation method known and conventional in the prior art? This limitation will be prosecuted with this interpretation.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Lilla.

Lilla teaches imparting fire retardant properties to wood by impregnating the wood with a sodium silicate solution and then treating to fuse the silicate to form glass in the voids of the wood (Col. 2, lines 24-52; Col. 3, lines 60-63; Claims 1-5). The teaching of Lilla also reads on the requirements of Claim 26, as the glass in wood voids would have separated some adjacent wood fibers from one another. The method of solution application taught by Lilla reads on the requirements of Claim 27, as it is known in the prior art of Lilla.

8. Claims 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Du Fresne et al.

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Du Fresne et al. teaches imparting fire retardant properties to wood by impregnating the wood with a sodium silicate solution and then treating the silicate to form silica (glass) in the voids of the wood (Col. 1, lines 22-58; Claim 11). The teaching of Du Fresne et al. also reads on the requirements of Claim 26, as the glass in wood voids would have separated some adjacent wood fibers from one another. The method of solution application taught by Du Fresne et al. reads on the requirements of Claim 27, as it is known in the prior art of Du Fresne et al.

9. Claims 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Clayton.

Clayton teaches impregnating wood with a sodium silicate solution and then hardening the silicate to a glass (Example 3; Claim 3). Clayton does not teach that fire retardance is imparted to the wood. However, since Clayton teaches the claimed process and material, it would have been expected that it would also inherently provide the same properties (i.e. fire retardance). Furthermore, the mere observation of still another benefit of an old process cannot form the basis of patentability (*Allen et al. vs. Coe* 57 USPQ 136). The teaching of Clayton also reads on the requirements of Claim 26, as the glass impregnated in wood voids would have separated some adjacent wood fibers from one another. The method of solution application taught by Clayton reads on the requirements of Claim 27, as it is known in the prior art of Clayton.

Allowable Subject Matter

10. Claims 22-23 are allowed.

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Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

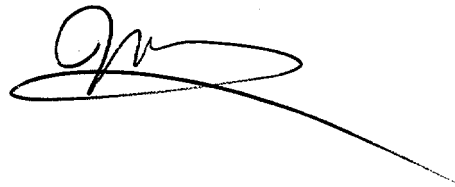
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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Barr whose telephone number is 703-305-7919. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 703-308-2333. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Michael Barr
Primary Examiner
Art Unit 1762

A handwritten signature in black ink, appearing to be 'MB', with a long, sweeping horizontal line extending to the right.

MB
September 4, 2003